

54



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,284	11/23/1999	QINGHONG CAO	CAO-2-2-11-1	3630
7590 03/10/2005 WILLIAM H BOLLMAN MANELLI DENISON & SELTER PLLC 2000 M STREET N W SUITE 700 WASHINGTON, DC 20036-3307			EXAMINER LY, NGHI H	
			ART UNIT	PAPER NUMBER
			2686	
DATE MAILED: 03/10/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/447,284

Applicant(s)

CAO ET AL.

Examiner

Nghi H. Ly

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,9,10,14,15,19,20,24,25,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,9,10,14,15,19,20,24,25,28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action (dated 12/29/04) is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 15, 25 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Borland et al (US 6,556,965).

Regarding claims 15 and 25, Borland teaches a method of integrating an MPEG audio player in a cordless telephone (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG") comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7) comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7), playing MP3 music from a remote handset of the cordless telephone (see column 5, lines 24-28), downloading digital bit stream music comprised in an MPEG format to the remote

Art Unit: 2686

handset directly form a remote bit stream audio source (see Abstract, column 3, lines 2-5 and column 4, lines 2-7), the remote bit stream music comprised in a MPEG format to the remote handset via an Internet (column 4, lines 27-33, see "transmission through Internet").

Regarding claim 28, Borland teaches a method of integrating an MPEG audio player in a cordless telephone (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG") comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7), playing MP3 music from a remote handset of he cordless telephone (see column 5, lines 24-28), downloading digital bit stream music comprised in an MPEG format to the remote handset directly form a remote bit stream audio source (see Abstract, column 3, lines 2-5 and column 4, lines 2-7), and for decompressing MPEG formatted music into digital music samples for digital to analog output (see Abstract, column 2, line 62 to column 3, line 24, see "compress" and "decompress\$5").

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 2, 4, 5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borland et al (US 6,556,965) in view of Rydbeck (WO 99/43136).

Regarding claim 1, Borland teaches a cordless telephone (see Abstract), comprising: a remote handset (see fig. 2, handset 110), a base unit matched to the remote handset (see fig. 2, handset 120), and an MPEG audio player integrated within at least one of the remote handset and the base unit (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG").

Borland does not specifically disclose the remote handset can switch between performing as a telephony device and performing as audio player, the switching being initiated upon activation of a button on the remote handset of the cordless telephone.

Rydbeck teaches the remote handset can switch between performing as a telephony device and performing as audio player, the switching being initiated upon

Art Unit: 2686

activation of a button on the remote handset of the cordless telephone (see page 7, lines 2-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rydbeck into the system of Borland in order to prevent telephone conversation from interfering with audio sounds.

Regarding claim 2, Borland further teaches the MPEG audio player is integrated within the remote handset (see column 5, lines 24-28).

Regarding claims 4 and 5, Borland further teaches the MPEG audio player is an MP3 (see Abstract, "MP3", column 4, lines 7-21, "MP3").

Regarding claim 29, Borland further teaches a cordless telephone (see Abstract), comprising: means for playing pre-loaded MP3 music from a remote handset of a cordless telephone (see fig. 2, handset 110), means for connecting a base unit of the cordless telephone to a public switched telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7).

Borland does not specifically disclose switching a remote handset of the cordless telephone from performing as a telephony device to performing as an audio player, and switching being initiated upon activation of a button on the remote handset of said cordless telephone.

Rydbeck teaches switching a remote handset of the cordless telephone from performing as a telephony device to performing as an audio player, and switching being initiated upon activation of a button on the remote handset of said cordless telephone (see page 7, lines 2-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rydbeck into the system of Borland in order to prevent telephone conversation from interfering with audio sounds.

7. Claims 14 and 24 are rejected under 35 U.S.C 103(a) as being unpatentable over Borland et al (US 6,556,965) in view of Ng.(US 6,430,530).

Regarding claims 14 and 24, Borland teaches a method of integrating an MPEG audio player in a cordless telephone (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG") comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7), playing MP3 music from a remote handset of the cordless telephone (see column 5, lines 24-28), downloading digital bit stream music comprised in an MPEG format to the remote handset directly from a remote bit stream audio source (see Abstract, column 3, lines 2-5 and column 4, lines 2-7), the downloaded digital bit stream music comprised in an MPEG format is stored in memory in the remote handset (see column 4, lines 22-39, "storage in portable systems").

Borland does not specifically disclose an MPEG format is stored in memory.

Ng teaches an MPEG format is stored in memory (see column 1, line 62-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Ng into the system of Borland so that the user can decodes and plays the file (see Ng, column 1, line 62-65).

8. Claims 9, 10, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borland et al (US 6,556,965) in view of Tuoriniemi et al (US 5,978,689).

Regarding claims 9 and 19, Borland teaches a method of integrating an MPEG audio player in a cordless telephone (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG") comprising: playing of the pre-loaded MP3 music from the remote handset of a cordless telephone (see column 5, lines 24-28), connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7) and playing of the pre-loaded MP3 (column 4, lines 27-33, see "storage in portable systems" and column 4, lines 43-47, see "playback").

Borland does not specifically disclose muting the playing of the pre-loaded music when the remote handset is active in a current telephone call.

Tuoriniemi teaches muting the playing of the pre-loaded music (see column 9, lines 17-20) when the remote handset is active in a current telephone call (see column 7, lines 49-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Tuoriniemi into the system of Borland so that the user won't miss the telephone call while enjoy listening to music.

Regarding claims 10 and 20, Borland teaches the method of integrating an MPEG audio player in a cordless telephone according to claims 9 and 19 (see Abstract,

Art Unit: 2686

"MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG").

Borland does not specifically disclose muting the playing of the pre-loaded music when the remote handset is active in a current telephone call.

Tuoriniemi teaches muting the playing of the pre-loaded music (see column 9, lines 17-20) when the remote handset is active in a current telephone call (see column 7, lines 49-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Tuoriniemi into the system of Borland so that the user won't miss the telephone call while enjoy listening to music.

Response to Arguments

9. Applicant's arguments with respect to claims 1, 2, 4, 5, 9, 10, 14, 15, 19, 20, 24, 25, 28 and 29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2686

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

NH Ly
03/04/05

Marsha D Banks-Harold
MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600